

REMARKS

Claims 1-20 are pending in the application.

Claims 1-20 are rejected.

Claims 1-3, 5-15, 18 and 20 are amended.

Reconsideration and allowance of claims 1-20 is respectfully requested in view of the following:

Explanation for Amendments to the Claims

Claims 1-3, 5-15, 18 and 20 have been amended to further clarify the claims with respect to managing insurance deductibles for new and renewal policies. These amendments notwithstanding, it is Applicants' explicit intent that the amended claims retain the full scope and breadth of the original, unamended claims including all equivalents thereto. Applicants respectfully submit that these amendments should in no way be interpreted as narrowing the scope or breadth of said claims, and that nothing herein should be interpreted to the contrary.

Responses to Rejections to Claims – U.S.C. §101

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicants respectfully submit that this rejection is not applicable to the amended claim.

As amended, claim 9 recites data structures as embodied in computer-readable media that provide a functional change when implemented using a computer system. Therefore, Applicants respectfully submit that amended claim 9 and claims dependent thereon are directed toward statutory subject matter.

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1-5 and 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rieker (U.S. Patent No. 5,832,447) (Rieker) in view of Bosco et al (U.S. Patent No. 5,191,522) (Bosco). Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rieker in view of Bosco in further view of Garrett et al (U.S. Patent No. 5,325,291) (Garrett). Applicants respectfully submit that these rejections are not applicable to the amended claims.

Independent claims 1, 9 and 15 contain similar recitations. For example, independent claim 1 recites, in part: "...providing a plurality of interrelated tables; providing a plurality of policy variables for each table; providing a first key reference in a first table, the first key

reference identifying a first specific group of the variables; matching the first key reference to a second table, the first key reference identifying a second specific group of variables and a plurality of additional key references; matching the plurality of additional key references to a plurality of respective additional tables, the additional key references identifying a plurality of additional specific groups of variables; and determining a deductible for a related policy renewal, wherein the determining comprises comparing a first deductible with a second deductible."

As the USPTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach "determining a deductible for a related policy renewal, wherein the determining comprises comparing a first deductible with a second deductible," as recited in claim 1.

As noted in the Office Action, the method disclosed in Reiker utilizes four tables (illustrated in Figs. 9A-D of Reiker). However, at no point does Reiker teach utilizing the tables for "determining a deductible for a related policy renewal" or "comparing a first deductible with a second deductible," as recited in claim 1. Rather, Reiker discloses "three high-level processes performed by a real-time [insurance] verification system" for a health care provider (col. 7, lines 24-26). The three processes – capture, communications, and control – disclosed in Reiker describe a method that retrieves and analyzes information of a patient's insurance coverage and outputs an indication of insurance eligibility (col. 7, lines 27-47). While the method of Reiker utilizes the tables noted in the Office Action, the tables fail to include any information regarding deductibles for an insurance policy and neither the tables nor the method disclosed by Reiker teach comparing a first deductible with a second deductible.

The Office Action also notes that Bosco discloses a database entity containing specific values, which may include a deductible, for benefits chosen by an insured person at col. 9, lines 10-18. However, Bosco fails to disclose "determining a deductible for a related policy renewal, wherein the determining comprises comparing a first deductible with a second deductible," as recited in claim 1. Rather, Bosco, in describing an integrated group health insurance processing system, discloses an entity-relationship model of an enterprise-wide insurance system data model (col. 5, lines 14-32). While discussing many of the entities in an insurance information system broadly and occasionally mentioning locations in the entity-relationship model where a deductible value might appear, Bosco fails to disclose a method directed toward determining a deductible for a policy renewal by comparing a first deductible with a second deductible. For example, in describing the "Class Provision Option Schedule," Bosco states:

"The allowable values per class provision from which the participant may select his or her own benefit levels per each offered coverage. This entity contains the value(s) per provision that the policyholder has chosen to make available to the participants according to coverage and class; each provision may have a single, required value (a mandatory default for all participants and dependents) or may allow for multiple options from which the applicant may choose his or her desired benefit. Example; the deductible on Comprehensive Dental is a flat \$50 for all employees provided that coverage." (col. 8, lines 15-26.)

Bosco also discloses allowing the client to choose a deductible amount as follows:

"A client would choose one of these standard default values during the design of the plan of insurance (case). For instance, the Enterprise may state that a Major Medical Deductible can be \$100, \$250 or \$500; the client may choose the \$250 option for all participants." (col. 12, lines 41-46.)

Bosco only discloses a method of a client choosing a deductible from among specific predetermined deductibles in designing an insurance plan with no mention of comparing a first and a second deductible in determining a deductible for a policy renewal. Applicants respectfully submit that these disclosures by Bosco fail to teach a technique of determining a deductible for a related policy renewal, wherein the determining comprises comparing a first deductible with a second deductible.

Garrett discloses nothing to remedy the deficiencies of Reiker and Bosco.

Dependent claims 2-8 depend from independent claim 1, dependent claims 10-14 depend from independent claim 9, dependent claims 16-20 depend from independent claim 15, and all are submitted as allowable for at least the reasons stated above.

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Thus, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1, 9 and 15 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1-20 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



Joseph R. Mencher
Registration No. 56,822

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Haynes and Boone, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512.867.8459
Facsimile: 214.200.0853
ipdocketing@haynesboone.com

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SC Li
Susan C. Lien